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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,753	09/19/2003	Grace Tallon	5-497-8	6985
27799 7590 02/11/2008 COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER MOHANDESI, JILA M				
ART UNIT 3728		PAPER NUMBER		
MAIL DATE 02/11/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/665,753

**Applicant(s)**

TALLON, GRACE

**Examiner**

Jila M. Mohandesi

**Art Unit**

3728

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE 11/28/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-12, 14-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12, 14-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3-5, 9-12, 14-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (5,791,482) in view of Ovadia (4,282,975). Murphy '482 discloses an artificial fingernail package comprising: a packaging frame (transparent wall 13) for storing a plurality of artificial fingernails of varying width and sizes; each of said artificial fingernails having a top surface, a bottom surface, and opposing longitudinal ends, and an exterior portion (transparent wall 12) that houses said packaging frame, said exterior portion defining a front and back of said package, said exterior portion comprising a transparent portion on the front of said package for allowing the arch height of at least one of said artificial fingernails to be observable outside of said package, wherein said packaging frame comprising a curvature-displaying compartment having at least two different ones of said artificial fingernails

and means for retaining said at least two different ones of said artificial fingernails such that at least one of a c-curve and an arch height of each of said at least two different ones of said artificial fingernails is observable outside of said package through said transparent portion of said exterior portion. See Figure 3 embodiment which is a side view of the package and clearly discloses two different ones of said artificial fingernails such that at least one of a c-curve and an arch height of each at least two different ones of said artificial fingernails is observable outside of said package through said transparent portion of said exterior portion. Murphy as described above discloses all the limitations of the claims except for the package containing a sponge-like material with a slit for receiving the artificial fingernails. Ovadia '975 discloses a display package with a sponge and slit (33 734) for better holding and displaying jewelry. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a sponge with slit to the package of Murphy as taught by Ovadia '975 for better displaying the artificial fingernails. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . . . [W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious."

With respect to the way the artificial fingernails are arranged in the holding material, this would be a design choice depending on the size and shape of the artificial finger nails and the holding material. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a

person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." The claim would have been obvious because "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense."

With respect to claim 4, note storage chamber (19), which stores a plurality of artificial fingernails.

With respect to claim 5, note display compartment (25) containing at least one said artificial fingernails, wherein the top surface of said one artificial fingernails is observable outside of said package through said transparent exterior portion.

With respect to claim 12 and the material of the package, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claim 11, Murphy discloses a package containing different sizes and curvature of artificial nails, which could be used as a nail tip.

Claims 18 and 20 are directed to the obvious method of packaging the artificial fingernails in the package of Murphy.

Claim 19 is directed to the obvious method of packaging the artificial fingernails in the modified package of Murphy.

4. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Aylott '614. Murphy discloses all the limitations of the claims except for adhesive compartment that contains adhesive, a stick compartment that contains a stick and a pin compartment that contains a push pin.

Aylott '614 discloses an artificial fingernail package that discloses an adhesive compartment as shown in Figure 1 embodiment for holding a container of adhesive (7) and a stick compartment also shown in Figure 1 embodiment for holding a manicure stick (9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an adhesive compartment and a stick compartment to the package of Murphy as taught by Aylott '614 for holding an adhesive container and a manicure stick.

The limitation under Official notice is now taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made and in view of the admitted prior art to provide an additional compartment in the package of Murphy for containing a push pin.

#### ***Response to Arguments***

5. Applicant's arguments filed 11/28/2007 have been fully considered but they are not persuasive. In response to applicant's argument that it is not obvious to arrange the longitudinal end of the artificial nail through the front of the package at a position substantially perpendicular to the bottom surface of the package, the claim would have been obvious because "a person of ordinary skill has good reason to pursue the known

options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the above references are directed to holding aesthetic small items, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a sponge with slit to the package of Murphy as taught by Ovadia '975 for better holding and displaying the artificial fingernails.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jila M Mohandesi/  
Primary Examiner  
Art Unit 3728

JMM  
February 05, 2008